

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 09/615,705
ATTORNEY DOCKET NO. Q60098

REMARKS

Applicants are concurrently filing a Request for Approval of Proposed Drawing Corrections with this Amendment.

Applicant herein cancels claim 18 without prejudice and/or disclaimer.

Claims 2, 4-7, 9, 11 and 14-17 and 19 remain withdrawn from consideration pursuant to 37 C.F.R. § 1.142(b) as being drawn to non-elected embodiments.

Applicant herein adds new claim 20. The new claim 20 is fully supported by the specification as filed, adds no new matter, and is readable on the elected species. Entry and consideration of new claim 20 is respectfully requested.

Claims 1-17, 19 and 20 are all the claims presently pending in the application.

Claims 1, 3, 8, 10, 12 and 13 have been examined, and are allowable for at least the following reasons.

1. Claims 3, 8, 10, 12 and 13 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Applicant traverses the rejection of claims 3, 8, 10, 12 and 13 for the following reasons.

The rejection of claims 3, 8, 10, 12 and 13 is premature. Claims 3, 8, 10, 12 and 13 are multiple dependent claims that depend from claims 1 and 2. Claim 1 was elected for prosecution on the merits and has been indicated as generic by the Applicant in the Response to Election of Species Requirement filed on March 21, 2001. The claims are not rendered indefinite because they depend from both elected and non-elected species. Therefore, it is unnecessary to consider the metes and bounds of claims 3, 8, 10, 12 and 13 with respect to claim 2. Claim 2 has been withdrawn from

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consideration, and the form of claims 3, 8, 10, 12 and 13 depending from non-elected claim 2 should simply be considered as withdrawn claims. Applicant respectfully requests that the Examiner withdraw the §112 rejection.

2. Claims 1, 3, 8, 10, 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ozaki et al. (U.S. Patent No. 4,456,939) in view of Miller (U.S. Patent No. 5,255,146). Applicant respectfully traverses the rejection of claims 1, 3, 8, 10, 12 and 13 and insofar as the rejection applies to new claim 20.

The Examiner acknowledges that Ozaki et al. fails to teach or suggest that the wire resistance of the ground potential wire between the ESD element connection point and the ground terminal is larger than the wire resistance of the ground potential wire between the ESD element connection point and the MOS capacitor connection point. *See* numbered paragraph 5, pages 3-4 of the Office Action dated August 15, 2001. To overcome the deficiencies of Ozaki et al., the Examiner states that the positioning of the ESD element connection point on the ground potential wire relative to the MOS capacitor connection point on the ground potential wire would be a matter of design choice within the skills of an artisan, and that computers are routinely used to design integrated circuit layouts.

The Examiner cites Cohn et al. (U.S. Patent No. 5,535,134) to support the position that it is well known to use computers in the design of integrated circuit layouts. *See* numbered paragraph 8, page 6 of the Office Action dated August 15, 2001.

Cohn et al. discloses, *inter alia*, a method for the location of objects (i.e., circuit elements) with an integrated circuit layout. However, nothing in Cohn et al. teaches or suggests the positioning of an electrostatic protection element with respect to an MOS capacitor, such that the ground wire resistance between the electrostatic protection element and ground terminal connection points is larger than the ground wire resistance between the electrostatic protection element and MOS capacitor connection points, as recited in claim 1. Thus, while the Examiner takes official notice that it is conventional to use computers to assist in the design of integrated circuit layouts, nothing in Ozaki et al. and Cohn et al. teach or suggest the resistance relationship as recited in claim 1.

Despite the Examiner's statements to the contrary (*see* numbered paragraphs 9 and 11, pages 7 and 8 of the Office Action dated August 15, 2001), Ozaki et al. lacks any teaching or suggestion of connecting a MOS capacitor in parallel with an electrostatic protection element between a power source wire and a ground potential wire, as recited in claim 1. In Fig. 2 of Ozaki et al., an external input terminal (103) is connected to a node (107) through a resistor (104). The node (107), in turn, is connected to the gate of a MIS transistor (101) that is part of an integrated circuit (102). While the Examiner claims that the node (107) is a power source, one of skill in the art would not supply power to an integrated circuit (102) through the gate of a MIS transistor.

As an alternative, the Examiner combines Ozaki et al. with Miller in order to overcome the acknowledged deficiencies of Ozaki et al. The combination of Ozaki et al. and Miller, however, fails to teach or suggest the invention recited in claim 1. The Examiner cites Miller, alleging incorrectly that it teaches the placement of an electrostatic protection element with respect to a ground terminal and a MOS capacitor, such that the ground wire resistance between the ground terminal and

electrostatic protection element connections is greater than the ground wire resistance between the electrostatic protection element and MOS capacitor connections. Figure 2 of Miller depicts a plurality of ESD protection circuits 14 connected between a V_{DD} ring and a V_{SS} ring.

The combination of Ozaki et al. and Miller fails to teach or suggest that the “wire resistance of said ground potential wire between a connection point on said ground wire with one end of said electrostatic protection element and said ground terminal is larger than a wire resistance of said ground potential wire between said connection point on said ground potential wire with one end of said electrostatic protection element and a connection point on said ground potential wire with the other end of said MOS capacitor” as recited in claim 1. In Figure 2 of Miller and its accompanying text, there is no indication that the ESD protection circuit 14 is positioned relative to a MOS capacitor such that the resistive relationship as recited in claim 1 is taught or suggested. At best, Ozaki et al. and Miller are cumulative, and simply illustrate that an electrostatic protection device can be connected to a signal input (Ozaki et al.) or power source wiring (Miller). The combination of references fails to show, however, the claimed resistance relationship between an electrostatic protection device and a capacitor, as recited in claim 1.

Applicant respectfully reminds the Examiner that, in order to establish a *prima facie* case of obviousness the prior art references must teach or suggest all the claimed limitations, and the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant’s disclosure. MPEP § 2142 (7th ed. 1998) citing *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). Critically, the Examiner has not pointed

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to any teaching or suggestion, in the combination of Ozaki et al. and Miller, of the claimed resistance relationship between an electrostatic protection device and a capacitor, as recited in claim 1.

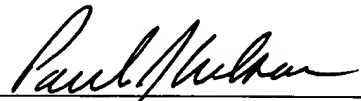
Thus, Applicant believes that claim 1 is allowable over the combination of Ozaki et al. and Miller, and Applicant further believes that claims 3, 8, 10, 12 and 13, as well as new claim 20, are allowable, at least by virtue of their dependency from claim 1.

Since claim 1 is generic to claims 2-17 and 19, Applicant respectfully requests that claims 2, 4-7, 9, 11, 14-17 and 19 be reinstated under 37 C.F.R. § 1.142(b) and indicated as allowable as well.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Please charge any fees necessary to maintain the pendency of this application, except for the Issue Fee, to our Deposit Account No. 19-4880.

Respectfully submitted,



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APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claim 18 is canceled without prejudice and/or disclaimer.

Claim 20 is added as a new claim.